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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09/943,190	08/29/2001	Campbell et al.	MI22-1668

EXAMINER

Renzo Rocchegiani

ART UNIT	PAPER
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DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

<b>Office Action Summary</b>	Application No. 09/943,190	Applicant(s) CAMPBELL ET AL.01
	Examiner Renzo N. Rocchegiani	Art Unit 2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## **Office Action Summary**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 08 September 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-42 is/are pending in the application.  
4a) Of the above claim(s) 31-42 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-30 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or déclaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.  
13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.  
14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## DETAILED ACTION

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-30 in Paper No. 6 is acknowledged.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-89 of copending Application No. 09/943,187. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the copending application (i.e. '187) claims the additional step of exposing the material to iodine, the claims of the present application do not limit the process from additional steps, further the '187 application claims that the chalcogenide material is partially doped and because the amount of doping is recognized to reflect the crystallinity and thus the property of the final chalcogenide member, it is a result effective variable and because

such doping is dependent upon the thickness of the metal layer deposited over the chalcogenide, such thickness is also result effective and thus obvious to optimize.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of copending Application No. 09/943,199. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the copending application (i.e. '199) claims the additional step of forming a passivation layer, the claims of the present application do not limit the process from additional steps, further the '199 application claims that the chalcogenide material is partially doped and because the amount of doping is recognized to reflect the crystallinity and thus the property of the final chalcogenide member, it is a result effective variable and because such doping is dependent upon the thickness of the metal layer deposited over the chalcogenide, such thickness is also result effective and thus obvious to optimize.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-6, 11-16, 20, 23-24, 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,638,820 B2 (Moore).

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Moore discloses a process to form a chalcogenide comprising non-volatile resistance device (col. 6, lines 7-9) comprising depositing a first electrode layer (item 16), depositing a chalcogenide material comprising Se and Ge (item 22 and col. 4, lines 16-25). Over the chalcogenide material a metal layer such as silver is deposited. (item 24, col. 4, lines 29-31). The thickness of the silver can be as low as one third the thickness of the chalcogenide material. (col. 4, lines 34-36). The structure is then irradiated so that the metal migrates into the chalcogenide material and breaks the chalcogenide bond at the interface with the metal thereby producing a homogeneous (col. 5, lines 40-50) amorphous, silver doped chalcogenide structure (item 23, col. 4, lines 36-50 and col. 5, lines 37-43). Finally, a second electrode layer is deposited over the chalcogenide material and shaped into an electrode device. (item 26)

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Moore does not explicitly disclose that the concentration of Ge is higher in the bottom portion of the chalcogenide material but such occurrence is inherent since the chalcogenide is being doped through diffusion from the top, thus there will necessarily be more dopant in the top portion than in the bottom portion thus the Ge concentration is relatively higher at the bottom than it is in the top. Furthermore, because Moore discloses that the doped chalcogenide material is amorphous, the thickness of the metal layer must inherently have been less than the "transition thickness".

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renzo Rocchegiani whose telephone number until January 6, 2004 is (703) 308-5839 and after January 6, 2004 is (571) 272-1904. The examiner can normally be reached on Monday through Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Smith, until January 6, 2004 can be reached at (703) 308-1323, and after January 6, 2004 can be reached at (571) 272-1907. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

RNR

November 21, 2003



MATTHEW SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800